

REMARKS

This application has been amended so as to place it in condition for allowance at the time of the next Official Action.

The Official Action rejects claims 1-6, 12, 13, 21-27, and 33 under 35 USC §102(b) as being anticipated by TOGNAZZINI. Reconsideration and withdrawal of this rejection are respectfully requested for the following reasons:

The Official Action identifies the applied reference with the designation EP 0817414 A2. Applicant has not identified such reference either on the PTO Form 892 attached to the Official Action nor any of the Information Disclosure Statements filed by applicant thus far. Applicant has researched the identified EP reference and discovered a corresponding U.S. Patent 5,708,478, and has based the present amendment and analysis thereon. Applicant respectfully requests that the next Official Action either identify the prior PTO Form 892 or IDS that identified the TOGNAZZINI reference, or include such reference in a future PTO Form 892.

Applicant further notes that the Official Action included an Examiner-initialled copy of an Information Disclosure Statement apparently filed in an unrelated application. The serial number of the application associated with such IDS is 09/679,503. The present application has Serial No. 09/697,503.

The TOGNAZZINI reference describes a computer system designed to enable radio listeners or television viewers to

obtain additional advertising information. Figure 1 provides an overall schematic view of the system, clearly illustrating that the advertisement capture processor 6 receives regular television or radio signals as inputs. Figure 2 of TOGNAZZINI provides a more detailed schematic representation of the advertisement capture processor 6.

As illustrated at the left of such drawing figure, the inputs to the system are AM or FM radio signals or television signals. The final two paragraphs in column 5 of TOGNAZZINI, beginning on line 45, provides a general overview of the function of the input device detector/decoder 16. As described therein, the detector/decoder 16 interprets the received signal and identifies those components that represent advertisement information. As specifically stated beginning at the top of column 6, the "device detector/decoder 16 then transmits the desired advertisement data to main central processing unit 18 for processing. Main central processing unit 18 then selectively formats and outputs the advertisement data upon the request of the user." As described throughout the rest of the reference, the device then selectively generates as output selected advertisement data, which is provided to the printer 10, display 12, or telephone 8, as also illustrated in Figure 2.

However, there exists a significant feature of the overall architecture of the TOGNAZZINI device best illustrated by reference again to schematic Figure 1. As is clear therefrom as

well as the balance of the applied reference, each of the identified output devices (telephone 8, printer 10 and display 12) is a device that is distinct and utterly separate from the device that the user uses to view and/or hear the programming content. Such programming content, as distinct from the advertising data, is presented to the user through television 2 or radio receiver 4. The TOGNAZZINI reference therefore makes clear that the intended approach is to provide an advertising-only outlet that can be controlled by the user and that is separate from the primary viewing/listening device.

This lies in stark contrast to the present invention, as best illustrated by present Figure 1. As illustrated therein, the receiver 101 receives a broadcast signal that includes both programming information and advertising information. The receiver then separates out the advertising information and provides only such advertising information to the memory 102.

The re-producer 104 receives a signal corresponding directly to the original broadcast stream, including both the program information and advertising information. The user, through a user interface, controls the controller 103 to selectively fetch portions of the advertisement information stored in the memory 102, and provide the same to the re-producer 104. The user also determines what content is sent by the re-producer 104 to the output that is directly sensed by the user.

In this way, the user can choose the combination program and advertisement stream that corresponds to the current broadcast stream, or can instead choose to receive selected portions of the advertisement information that have automatically been stored in the memory 102.

However, regardless of whether the user chooses to hear the full program and advertising broadcast stream or recorded advertisement information only, the user receives such selected output through the same output. Accordingly, the user utilizes a single output device to enjoy whatever content he currently desires, and does not need to refer to a completely distinct output device to receive the selected advertisement information, as TOGNAZZINI requires.

Accordingly, applicant has amended each of original independent claims 1 and 22 to recite characteristics of the present invention that underlie the distinction described above. The TOGNAZZINI reference not only fails to disclose the present invention, but also suggests away from the present invention as recited, as such reference clearly indicates a preference to use distinct devices for user enjoyment of the regular broadcast stream and the temporarily stored advertisement information.

Applicant has amended other of the original claims as to matters of form, and to ensure consistency with the amended independent apparatus claim 1 and method claim 22.

In addition to such amendments, applicant has added new claims 35-38, of which claim 35 is independent. Independent claim 35 recites features of the present invention undisclosed by the applied TOGNAZZINI reference or any other known prior art. Claims 36-38 recite additional features of the present invention including the digital/analog nature of the information at various points in the data flow, as well as the memory architecture used to store the advertisement information. The characteristics of the stack memory are described on at least pages 21 and 22 of the present specification. The digital and analog nature of the various signals is described in at least the passage beginning on page 18, line 10.

The Examiner has rejected claims 7-9, 14-20, 28-30 and 34 under 35 USC §103(a) as being unpatentable over the same TOGNAZZINI reference. The stark differences between the TOGNAZZINI device and the present invention, particularly as manifest in the amended independent claims 1 and 22, are addressed in detail in connection with the anticipation rejection above.

Applicant notes that the applied reference no more teaches or suggests the full set of features in the amended claims than it does specifically disclose the same. Moreover, applicant suggests that the TOGNAZZINI reference teaches away from the invention as now recited, as it explicitly requires use of one output device for enjoying the regular broadcast stream

and an utterly distinct and separate device for providing the stored advertising information.

Applicant therefore respectfully suggests that the TOGNAZZINI reference fails to provide the basis for a *prima facie* case for obviousness.

The Official Action rejects claims 10, 11, 31, and 32 under 35 USC §103(a) as being unpatentable over the previously-considered TOGNAZZINI reference in view of HEJNA, JR. The secondary reference is offered only for its asserted teaching or suggestion of a second type attribute to reproduce the advertisement information at a predetermined normal speed until the end of the advertisement.

However, irrespective of the ability of such secondary reference to teach or suggest that which it is specifically offered, it nevertheless fails to overcome the shortcomings of the primary TOGNAZZINI reference for all of the reasons discussed in detail in the preceding rejections. Reconsideration and withdrawal of this rejection are therefore respectfully requested.

In light of the amendments provided above and the arguments offered in support thereof, applicant suggests that the present application is in condition for allowance and an early indication of the same is respectfully requested.

If the Examiner has any questions or requires further clarification of any of the above points, the Examiner may



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contact the undersigned attorney so that this application may continue to be expeditiously advanced.

Please charge the fee of \$200 for the four claims of any type added herewith, to Deposit Account No. 25-0120.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Eric Jensen".

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